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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/812,609 | 03/30/2004 | Paul Re | SCAN-1 CON | 3229 |
| 7590 Mark J. Pandiscio Pandiscio & Pandiscio 470 Totten Pond Road Waltham, MA 02154 | | | | |
| EXAMINER | | | | |
| BACHMAN, LINDSEY MICHELLE | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3734 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 10/16/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,609

Applicant(s)

RE ET AL.

Examiner

LINDSEY BACHMAN

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 9, 16, 17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 9, 16, 17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's amendment filed 16 July 2008.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 9, 12, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulhauser, et al. (US Patent 6,267,772) in view of DiPoto et al. (US Patent 5,690,676).

Claims 1 and 3: Mulhauser'772 teaches a tissue repair device (10) containing a body containing an annular frame portion (14) and an integral, solid cover portion (12; column 4, lines 51-59) disposed within the frame portion (see side view in Figure 2b). Further, the device contains legs (22). Mulhauser'722 teaches that the cover portion can be bowed proximally (column 3, lines 60-61). Mulhauser'772 does not teach that the

legs are several times longer than the thickness of the body, nor do the legs contain central channels.

DiPoto'676 teaches a device for penetrating the body comprising a leg (16) that contain a central channel (34) that is closed at the distal end. The leg further contains a tapered portion (60) and an end portion that is enlarged circumferentially (62). It would have been obvious to one skilled in the art at the time the invention was made to modify the device taught by Mulhauser'772 with the legs taught by DiPoto'676 because they are longer and capable of engaging the tissue better and are more easily used with a deployment tool because the central channel can engage with the deployment tool (see Figure 1-3). Further, it would be obvious to one of ordinary skill in the art to use a known technique on a known device for improvement to yield predictable results.

Claim 9: Mulhauser'772 teaches attaching the cover to the frame using insert molding (column 4, lines 26-34).

Claim 16: Mulhauser'772 teaches that the fabric can be made of absorbable material (column 4, lines 35-51).

Claim 17: Mulhauser'772 teaches that the cover can be a material which promotes cell growth (column 4, lines 35-51).

Claim 20: Mulhauser'772 teaches a method of repairing a cartilage defect that includes providing a body for disposition against a bone with a defect in which the device contains elongated leg structures (22) for disposition into the bone and bring the distal surface of the device into contact with the bone (column 7, lines 13-35 and column 3, lines 39-41). Mulhauser'722 teaches that the solid, cover portion (12; column

4, lines 51-59) can be bowed proximally (column 3, lines 60-61). Mulhauser'772 does not teach that the legs are several times larger than the thickness of the body, nor do the legs contain central channels that extend partially through the legs, nor is the cover member made of metal.

DiPoto'676 teaches a device for tissue fixation with legs (16) that are several times longer (see Figure 11-13) in order to firmly hold the leg in place. The device contains a central channel (34) that extends only partially through the leg in order to allow the device to be grasped with a tool (Figure 1-3). It would have been obvious to one skilled in the art at the time the invention was made to modify the legs taught by Mulhauser'772 with the legs taught by DiPoto'676 because they are longer and capable of engaging the tissue better and are more easily used with a deployment tool because the central channel can engage with the deployment tool (see Figure 1-3). Further, it would be obvious to one of ordinary skill in the art to use a known technique to a known device for improvement to yield predictable results.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./
Examiner, Art Unit 3734

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773